

et al., patent number 5,689,550 (hereinafter *Garson*). Claims 8-11, 28-32, 34-56, 78, 79, and 85 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Albal* in view of Maxwell, patent number 5,805,810 (hereinafter *Maxwell*). Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Albal* in view of Kuzma, patent number 5,771,289 (hereinafter *Kuzma*). Claims 33 and 80 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Albal* in view of *Maxwell* and further in view of *Garson*. Claims 57-66 and 70-74 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Albal* in view of Berkowitz et al., patent number 5,903,877 (hereinafter *Berkowitz*). Claims 67-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Albal* in view of *Berkowitz* and further in view of *Maxwell*.

A. The Independent Claims

Claim 1 has been amended to recite:

means at least in part operable at said third location for reproducing for delivery to said second location said received electronic document in a plurality of different formats, wherein a particular format of said formats utilized in reproduction for delivery is preselected by an intended recipient of said document.

No new matter has been added as the subject matter of the claim amendment appears in the specification, *inter alia*, at page 15, lines 18-29. Additionally, new claims 87-89, depending from claim 24, have been added, reciting additional particulars of the above identified disclosure.

The applied art does not teach or suggest the selection of delivery formats by the intended recipient of a document. In fact, the disclosure of *Albal* expressly teaches the opposite of the recited limitation, teaching that the sender defines the delivery parameters, see column 8, lines 61-62.

Moreover, one of ordinary skill in the art would not have found the invention of claim 1 obvious from reviewing *Albal* as the disclosure therein teaches that the sender defining the delivery parameters “is an important aspect of the present invention in that the sender is given the ability to set the delivery parameters of the payload which the sender typically compiled

and/or is fully knowledgeable of the contents,” column 8, lines 62-66. M.P.E.P. § 2141.02 directs that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” “A prior art reference that ‘teaches away’ from the claimed invention is a significant factor to be considered in determining obviousness,” M.P.E.P. § 2145. Accordingly, Applicants respectfully assert that claim 1, and the claims dependent therefrom, would not have been obvious under 35 U.S.C. § 103 over *Albal*.

Claim 27 has been amended to recite that the “authentication information includes information with respect to pre-payment for transmission of said transmitted document deducted from a credit register stored at said first location,” substantially as presented in dependent claim 29. Accordingly, dependent claims 29 and 30 have been canceled.

In rejecting original claim 29, the Examiner asserts that the limitations recited therein are obvious over *Albal* and *Maxwell* as *Maxwell* teaches the pre-payment is deducted from a credit register stored at the first location, citing column 9, lines 6-11 and lines 19-30, Final Office action at page 15. However a review of *Maxwell* reveals that the disclosure therein teaches that message validator 22 accesses sender database 1300 to locate an account record for the sender. As taught at column 5, lines 12-17, the message validator is a part of the netgram workstation which also stores the sender database. This netgram workstation is coupled to the sender through the Internet, see column 4, lines 20-23 and 43-48. Therefore Applicants respectfully assert that *Maxwell* does not teach transmission of a document from a first location to a third location with information of a pre-payment deducted from a credit register stored at the first location, but instead expressly teaches that the sender database referenced for account information is stored at the intermediate netgram workstation location. Moreover, it is asserted that the system of *Maxwell* cannot be read to meet this limitation as the sender location and the sender credit record locations are two separate locations which cannot reasonably be read as a first location.

Additionally, Applicants respectfully assert that the Examiner has not properly established a *prima facie* case of obviousness with respect to combining *Albal* and *Maxwell* to meet the present claims. To establish a *prima facie* case of obviousness, the first of three basic criteria which must be met is that there must be some suggestion or motivation, either

in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, see M.P.E.P. § 2143.

However, the Examiner's proffered motivation to combine the references with respect to both claim 29 and claim 32 is merely that "*Albal*'s system could easily be modified to include *Maxwell*'s teachings, as the two systems have cumulative features." This statement says nothing more than the references can be combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, M.P.E.P. § 2143.01, citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification. Accordingly, Applicants assert that claims 27 and 32, as well as the claims dependent therefrom, are allowable over the rejections of record.

Claim 57 as rejected recites "a reproducing circuit adapted to reproduce said information in human readable form, wherein said reproducing circuit also produces an indicia authorizing delivery of said human readable information" In order to more clearly define the invention described by the above limitation, Applicants have amended claim 57 to recite "said reproducing circuit also produces an indicia of payment authorizing delivery," as is clearly described in the specification at page 39, lines 17-21.

In rejecting claim 57, the Examiner relies upon *Albal* at column 9, lines 38-64, wherein a message for delivery to a postal address is discussed. There is no hint or suggestion of printing an indicia authorizing delivery as recited in the claim. Moreover, a review of column 9, lines 55-62, wherein actual printing of a message is described, does not reveal any suggestion of printing a payment indicia authorizing delivery. This deficiency in the prior art is not addressed in the secondary reference *Berkowitz*. Accordingly, Applicants assert that claim 57 and the claims dependent therefrom are allowable over the rejection of record.

Additionally, Applicants respectfully assert that the Examiner has not properly established a *prima facie* case of obviousness with respect to combining *Albal* and *Berkowitz*. As discussed above, to establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, see M.P.E.P. § 2143. However, the Examiner's proffered motivation to combine the references with respect to claim 57 is merely that "*Albal*'s system could easily be modified to include *Berkowitz*'s converter circuit, as the systems share cumulative features." This statement says nothing more than the references can be combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, M.P.E.P. § 2143.01, citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

Applicants have amended claim 57 to remove recitation of the acknowledgment circuit as Applicants have shown that the prior art of record does not otherwise meet the claim. Accordingly, claim 67, dependent therefrom, has been amended to reflect this amendment of claim 57. The limitation originally submitted in claim 57 has now been submitted in dependent form in new claim 90. No new matter has been added.

Claim 75 has been amended to include the limitation originally presented in dependent claim 79. Accordingly, claim 79 has been canceled. Claim 75 as amended recites:

means at least in part operable at said first location for transmitting a document to said third location, said transmitting means also transmitting information with respect to a value for delivery of said document, wherein said value information includes an indicia of credit deducted from a credit storage device coupled to said transmitting means

In rejecting the limitation of claim 79, as with the rejection of claim 29 discussed above, the Examiner asserts that the limitations recited therein are obvious over *Albal* and *Maxwell* as *Maxwell* teaches the pre-payment is deducted from a credit register stored at the first location. However, as discussed in detail above, *Maxwell* teaches that message validator 22 accesses sender database 1300 to locate an account record for the sender, both of which are part of the netgram workstation which is coupled to the sender through the Internet, see column 4, lines 20-23 and 43-48, and column 5, lines 12-17. Therefore Applicants respectfully assert that *Maxwell* does not teach including value information with the document wherein the value

information includes indicia of credit deducted from a credit storage device which is transmitted to the third location.

Moreover, as with the rejection of the limitation recited in claim 29 discussed above, Applicants respectfully assert that the Examiner has not properly established a *prima facie* case of obviousness with respect to combining *Albal* and *Maxwell* to meet the present claims. To establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, see M.P.E.P. § 2143. However, the only statement of motivation provided to combine the references is that “*Albal*’s system could easily be modified to include *Maxwell*’s teachings, as the two systems have cumulative features.” This statement says nothing more than the references can be combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, M.P.E.P. § 2143.01, citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

In addition to the above described amendment, claim 75 has been amended to further clarify and define the invention recited therein. Specifically, claim 75 has been amended to recite selection of the third location based on a relative position of at least one of the first and second locations. No new matter has been added as the amendment merely clarifies the language originally submitted and is consistent with that of page 32, lines 14-25.

As shown above, each of the independent claims includes limitations which are neither taught nor suggested by the applied art. Moreover, as the claims dependent therefrom include all the limitations of the base claim from which they depend, the dependent claims are *a fortiori* allowable over the art of record.

B. The Dependent Claims

The dependent claims add additional new and non-obvious limitations not found in the art of record. For example, claim 2 recites time stamping the transmitted document

according to a secure real time clock, such as is described at page 7, line 25, through page 8, line 6. There is no hint or suggestion of a secure real time clock meeting the claims by the mere mention of displaying a log message on a console along with a data and time stamp as described in *Garson*, relied upon by the Examiner in rejecting the claim.

Similarly, claim 10 recites a credit storage device including an internal time device providing time information included in the document transmitted from the first location to the third location. The disclosure of *Maxwell* teaching a partial mail object queue wherein partial mail objects which have not been completed within a particular time are deleted, column 11, lines 13-32, does not meet the claim as asserted by the Examiner.

Claim 72 recites a limitation similar to that of claim 2 discussed above, adding the requirement that the secure time piece be disposed at the transmitting location. Accordingly, claim 72 provides ancillary information with the transmitted document including a time of transmission of the document by the transmitting means wherein the time is provided by a secure time piece disposed at the transmitting location. The mention of delivery parameters including the time for delayed delivery provided in *Albal* at column 9, lines 1-3, and relied upon by the Examiner in rejecting claim 72, does not meet either the requirement that the time is transmitted with the document from the transmitting location recited in the claim or even the time information which is transmitted.

Moreover, there is no hint or suggestion of a secure time piece by this disclosure, although the Examiner relies upon the assertion that a secure time piece would inherently be used by a workstation. However, in order to properly establish a rejection based on inherency, “the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” M.P.E.P. § 2112, citing *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis original). A reference may not be anticipating under the principle of inherency on the basis of possibilities or probabilities, as anticipation by inherency requires that persons skilled in the art would recognize that the missing material is “necessarily present” in the reference, see *In re Robertson*, Fed. Cir., No. 98-1270, 2/25/99. The Examiner’s statement that “a secured time

piece would inherently be used by a workstation” does not reasonably support a conclusion that the claimed secure time piece flows from the disclosure of the prior art.

Claim 7 recites additional information transmitted with the document from the first location to the third location including an indication of payment for the service of transmitting the document. Claim 9 further recites that the indication of payment is an indicia of payment deducted from a credit storage device coupled to the transmitting means. Similarly, claim 49 recites an indication of pre-payment deducted from a credit storage device being transmitted accompanying the transmitted document. As discussed above with respect to claims 27 and 75, the art of record does not teach or suggest such a limitation.

Conversely, claim 50 recites the indication of pre-payment being provided by a recipient of the transmitted document. The Examiner relies upon the disclosure of *Maxwell* to meet this limitation. However the disclosure therein is limited to payment by the sender, see column 9, lines 37-40.

Similar to claim 57 discussed above, claim 19 has been amended to more clearly recite reproducing an indicia of payment for authorization to deliver the transmitted document. The disclosure of *Albal* describing authorizing users, relied upon by the Examiner in rejecting the claim, is insufficient to meet the claim, see column 8, lines 15-18. As discussed above with respect to claim 57, Applicants assert that there is no hint or suggestion of printing an indicia authorizing delivery as recited in the claim provided by the disclosure of *Albal*.

Moreover, claim 20 further recites the indica comprising a postage meter stamp. Although the Examiner relies upon the disclosure of *Kuzma* to meet this limitation, a review of that reference reveals that it is an electronic stamp recognized by an electronic post office which is disclosed therein, see column 4, lines 39-41. There is no hint or suggestion of printing a document and an associated postage meter stamp for delivery by the disclosure of *Kuzma*, nor has the Examiner suggested otherwise.

Claim 26 recites sorting a plurality of transmitted documents according to a criteria selected from the group consisting of a delivery route, a recipient, a class of delivery and a sender. However, the disclosure of *Albal* relied upon by the Examiner in rejecting the claim teaches value added services such as Directory Services, Business/Accounting Services,

Security Services, Compression Services, and Language Services. There is no hint or suggestion provided by the brief description of these services of any sorting of a plurality of transmitted documents, much less the particular sorting criteria recited in claim 26.

Claim 59 recites selection of the intermediate location by the transmitting location referencing address information with respect to the selected intermediate location. There is no hint or suggestion in the art of record of a transmitting location selecting an intermediate location by the intermediate location's address information.

Claim 86 recites a database designating at least one of certain types of documents and particular senders for which document delivery is to be forgone. The disclosure of *Albal* relied upon by the Examiner in rejecting the claim merely teaches that a user establishes a database of payload entries specifying the applicable communication methods to be used when communicating with the respective recipients, see column 8, lines 34-37. There is no hint or suggestion of foregoing delivery of any documents nor the designation of types of document or particular senders for which to forego delivery.

In addition to the differences identified above, Applicants respectfully assert that the Examiner has not established a *prima facie* case of obviousness with respect to the dependent claims rejected under 35 U.S.C. § 103. As discussed above with respect to the independent claims, in order to establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, see M.P.E.P. § 2143. However, the motivation provided to combine references in the Office Action is that the references have cumulative features and that the primary reference could easily be modified. This statement says nothing more than the references can be combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, M.P.E.P. § 2143.01, citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

C. The New Claims

New claim 87 recites a database of preferred delivery methods selected by document recipients. New claim 88 further recites use of the identity of senders for selection of a particular delivery method to be used. New claim 89 further recites use of the type of documents for selection of a particular delivery method to be used. There is no hint or suggestion in the art of record of a recipient establishing a database containing preferred delivery methods. By contrast, the primary reference *Albal* teaches that it is an important feature of the system described therein that the sender defines the delivery parameters, see column 8, lines 61-66.

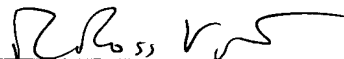
II. Summary

As shown above, there are great differences between the claims and the prior art. Moreover a person of ordinary skill in the art considering the prior art would not find these differences obvious. Accordingly, Applicants respectfully traverse the Examiner's 35 U.S.C. § 103 rejections of record. Therefore, Applicants respectfully request that the claims be passed to issue.

Applicant respectfully requests that the Examiner call him at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

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